

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

16
Declarative

In re Patent Application of

YACCARINO III

Serial No.: 09/503.166

Filed: February 14, 2000

For: COMPOUND BONE STRUCTURE
OF ALLOGRAFT TISSUE WITH
THREADED FASTENERS

EXAMINER PHAN

Group Art Unit 3738

The Honorable Commissioner of
Patents and Trademarks
Washington, D.C. 20231

Sir:

SUPPLEMENTAL DECLARATION OF JOSEPH A. YACCARINO, III
UNDER 37 CFR 1.131

COMES NOW, JOSEPH A. YACCARINO, III, who avers and swears that the following statements are true to the best of his belief and knowledge:

1. I am an engineer employed by MUSCULOSKELETAL TRANSPLANT FOUNDATION and in the course of my employment, I designed a compound bone structure for allograft tissue.
2. That Synthes Corporation markets products manufactured by MUSCULOSKELETAL TRANSPLANT FOUNDATION including the compound bone structure and in the course of my work, I interface with David C. Paul of Synthes Corporation.
3. That during the development stage of the compound bone structure noted above, I worked with David C. Paul of Synthes Corporation.
4. That prior to the provisional application filing date of August 3, 1998 which later

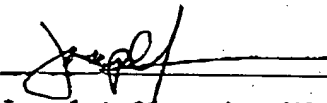
issued as U.S. Patent Number 6,258,125 to Paul et al., I worked upon, developed and was an inventor of the device which is substantially shown in Figures 7, 8, 8A and 11 of the '125 patent. (Exhibit A)

5. That the 6,258,125 patent does not claim the same patentable invention as is claimed in the present '166 application and the '125 patent issued less than one (1) year prior to the filing of the present '166 application. Indeed, the '125 patent issued over one year and four months after the filing date of the '166 application.
6. That substantially the same device shown in the drawings of Figures 7, 8, 8A and 11 of the '125 patent were conceived and reduced to practice prior to the provisional filing date of August 3, 1998 of the '125 patent.
7. That a continuation application of the '125 patent (same specification and same drawings) was filed by David C. Paul et al. and assigned to Synthes Corporation and I was added as an inventor to this continuation application. My ownership rights were assigned to Musculoskeletal Transplant Foundation. This application is jointly owned by Synthes Corporation and Musculoskeletal Transplant Foundation.
8. That both David C. Paul and I are inventors of record in United States Letters Patent Number 6,025,538, filed November 20, 1998 (Paul being added after issuance) The application which issued into the '538 patent was filed almost four (4) months after the filing date of the provisional application which issued into the '125 patent and issued February 15, 2000, one (1) year and four (4) months before the '125 patent issued and issued on July 10, 2001. The '538 patent is the parent application of the present '166 continuation-in-part application. The 6,025,538 patent is jointly owned by Synthes Corporation and Musculoskeletal Transplant Foundation as each of the inventors has assigned his interest to his respective corporation.
9. That the parent case of this continuation-in-part application (U.S. Patent Number 6,025,538) of the present continuation-in-part '166 application included figures corresponding to Figures 7, 8, 8A and 11 of the '125 patent. (Exhibit B)
10. That the present '166 application is in the process of adding David C. Paul as an inventor and the application will be jointly owned by Synthes Corporation and Musculoskeletal Transplant Foundation.

The undersigned declares that all facts and allegations contained in this declaration are true to the best of his knowledge; all statements made herein of his own knowledge are true and that all statements made on information an belief are believed to be true; and further, that these statements and the like so made are punishable by fine or imprisonment or both, under Section 1001 of Title 18 of the United States code and that such willful false statements may jeopardize the validity of the application or document or any registration resulting therefrom.

Respectfully submitted,

Date: January 27, 2003



Joseph A. Yaccarino, III